

Attorney Docket No.: ISPH-0567
Inventors: Bennett et al.
Serial No.: 09/938,048
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The claims of the present application have been subjected to a Restriction Requirement under 35 U.S.C. §121 by the Examiner in this case as follows:

Group I, claims 1-14 drawn to a method of identifying one or more genes involved in a response by a cell, tissue or organism via an antisense library, classified in class 435, subclass 6;

Group II, claims 15-22, drawn to a method for identifying one or more genes involved in a phenotype of a cell, tissue or organism via an antisense library, classifiable in class 534, subclass 6;

Group III, claims 23-25, drawn to a method for identifying genes expressed in dendritic cells that regulate co-stimulation of T-cells via an antisense library, classified in class 435, subclass 6;

Group IV, claims 26-28, drawn to a method for identifying genes that play a role in T-cell-mediated inflammation via an antisense library, classified in class 435, subclass 6; and

Group V, claim 29, drawn to a prevalidated antisense oligonucleotide library of 10-10,000 members, classified in class 536, subclass 24.5.

The Examiner suggests that the inventions are distinct each from the other. It is suggested that Groups I through IV, and V

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are related as product and process of use. Groups I through IV are suggested to be unrelated, as requiring the use of different antisense compounds in order for the libraries to provide the required observations of the claims.

It is further suggested that the present application contains patentably distinct species. For Group I, Applicants are required to elect one response from : secretion of a compound, modulation of expression of a cell surface protein, modulation of inflammation, inhibition of response, stimulation of response, modulation of apoptosis, modulation of cell cycle profile, modulation of angiogenesis, modulation of insulin signaling, modulation of glycogenolysis, and modulation of adipocyte differentiation.

For Group II, Applicants are required to elect one disease state from: cancer, undesired angiogenesis, inflammation or metabolic disorder. Applicants must also elect one species of secondary phenotypic assay from: a low density array, a tertiary phenotypic assay and a high density array.

For Groups III and IV, Applicants are required to elect one cytokine.

Applicants respectfully traverse this restriction requirement.

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MPEP §803 is quite clear: for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

All of the claims are related to the use of antisense oligonucleotide libraries for identifying a gene function. Thus, Applicants respectfully disagree with the Examiner's suggestion that designated groups are distinct as being novel and unobvious over each other as required by MPEP § 802.01; or that any additional search would be required by the inclusion of all of the groups. Accordingly, reconsideration and withdrawal restriction requirement is respectfully requested.

Additionally, MPEP § 803 recites that [i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it

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includes claims to independent or distinct inventions. Groups I and II both relate to a method of using an antisense library to characterize and distinguish cells. Therefore, Applicants respectfully request that the claims of Groups I and II be allowed to be examined together as one grouping, as there would be no serious burden placed on the Examiner.

However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute Group I, claims 1-14. Applicants hereby further elect the species indicated as "modulation of inflammation", with traverse.

Respectfully submitted,

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